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EXAMINER

THOMPSON JR, FOREST

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3625

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 09/294,461
Filing Date: April 19, 1999
Appellant(s): SHANMAN ET AL.

MAILED

APR 21 2003

GROUP 3600

Bruce L. Adams
For Appellants

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/10/2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellants' statement of the status of amendments after final rejection contained in the brief is correct. Appellants' amendment D after Final filed with a certificate of mailing dated Nov. 1, 2002, canceling claims 1-8, 11-13 and 25-28, has been entered. Claims 29-40 remain pending.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The Appellants' statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellants' brief includes a statement that claims 29-40 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

"Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire, p106NYM035; 06 January 1997.

"Excite Reports First Quarter 1999 Results;" PR Newswire, SFTH077; 15 April 1999.

5,848,399	BURKE	12-1998
6,014,634	SCROGGIE et al.	01-2000
6,055,513	KATZ et al.	04-2000

(10) Grounds of Rejection

The following ground(s) of rejection as presented in the FINAL REJECTION (see Paper #13) are applicable to the appealed claims. Claims 1-8, 11-13 and 25-27 have been cancelled by Appellants in Paper #15, but were examined in the FINAL REJECTION, and are repeated below from Paper #13 for clarity and completeness since some of the remaining claims were rejected with reference to claims that have now been cancelled by Appellants:

(a) Claims 1-2, 4-8, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "ZIP COUPONS"), and further in view of "Excite Reports First Quarter 1999 Results," PR Newswire, 15 April 1999 (hereafter referred to as Excite) and Scroggie et al. (U.S. Patent No. 6,014,634).

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Claim 1: ZIP COUPONS (at pg. 1, para. 2) discloses:

- a plurality of consumer units operated by a consumer;
- communications means connectable over a communication medium to at least a coupon server; a user input device to permit a consumer to make one or more choices displayed on the display monitor; a coupon server located remotely from the consumer units, comprising:

- a memory for storing first data corresponding to one or more participating retail outlets including data for identifying each of the retail outlets by name and inventory of goods offered for sale, and second data containing coupon data used for generating electronic discount coupons for selected goods;

- a data processing unit having communication means connectable over the communication medium to the consumer units;

- first means responsive to a connection with a respective consumer unit to transmit for display on the display monitor of the respective consumer unit a first rule containing a list of participating retail outlets which may be individually selected by the consumer using the user input device of the respective consumer unit, *through the selection of the types of coupons that the consumer is interested in, and display of available coupons and the associated merchants identified with the coupons;*

- second means responsive to the selection of a retail outlets displayed on the display monitor of the respective consumer unit by the consumer to transmit to the respective consumer unit a second file containing first data corresponding to the

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selected retail outlet for display on the display monitor of the consumer unit, the second file containing the identity of goods offered for sale by the selected retail outlet, and the displayed goods being individually selected by the consumer using the user input device, *as illustrated through the representation and selection of the coupons*; and

-- third means responsive to the selection of one or more items of goods by the consumer to transmit a third file for display on the display monitor of the consumer unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods, *i.e., through the selection of coupons for desired products/services, the consumer is selecting products/services for purchase.*

ZIP COUPONS disclose that advertisers will pay Internet Infinity, Inc. for placement of their zip coupons on the Internet and delivery of their mail coupon, and customers will select a coupon interest category for car wash, pizza, etc., which implies that a list of the participating retail outlets are displayed on the display monitor of the consumer unit. However, ZIP COUPONS does not explicitly show the retail outlets are individually selectable by the consumer and in response to the selection of one or more of the displayed retail outlets transmitting a list of goods for which discounts are available. However, this is inferred from the disclosure of ZIP Coupons, as shown above, as the consumer selects the coupons for products that the consumer wants to obtain, and the coupons are provided to the consumer. Official Notice is taken that the consumer may base his choices on any one or more of many parameters, such as, cost, size, color, etc. of the choices, as well as, the particular merchant providing the

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coupon redemption service that sells the products of choice. In this way, the consumer selects the merchant that he prefers. It would have been obvious to one skilled in the art at the time the invention was made to modify ZIP Coupons to specifically disclose the retail outlets are individually selectable by the consumer and in response to the selection of one or more of the displayed retail outlets transmitting a list of goods for which discounts are available, because this is only an obvious variation of the disclosure that results from a slightly different, but obvious, sort of the same database of available goods and coupons. Thus, when coupons are selected for each of the participating stores as disclosed in ZIP COUPONS, products and retail stores are being individually selected by the consumer.

Additionally, EXCITE discloses that consumers are able to access digital redeemable coupons from participating online merchants, all personalized based on an individual's shopping interests (pg. 2 3rd para.), as may be portrayed by a shopping list. It would have been obvious to one skilled in the art at the time the invention was made to modify the invention of ZIP COUPONS to disclose a list of participating retail outlets in such a manner that the retail outlets are individually selectable by the consumer and transmitting a list of goods for which discount coupons are available in order for the individual to view and select products available from the retail outlet, as disclosed by EXCITE, because this would simplify the consumer's selection procedures for goods and retail outlets. When coupons are selected for each of the participating stores as disclosed in ZIP COUPONS and EXCITE, simultaneously, products and retail stores are individually selected by the consumer.

Additionally, Scroggie discloses:

- using a first computer operated by a consumer to establish a connection with a second computer over a communication medium (col. 1 lines 47-64);
- using a second computer to acquire identifying indicia for identifying the geographical location of the first computer (col. 1 lines 52-61);
- selecting from a list of participating retail outlets stored in the second computer one or more participating retail outlets in the geographical vicinity of the first computer (col. 1 line 47 - col. 2 line 17);
- disclosing the steps include logging in a remotely located customer using identity data and geographic region data transmitted by the customer over a communication network; transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region; and then receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised (col. 1 lines 56-64);
- the functionality of transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region (col. 1 lines 56-64);
- receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised (col. 1 lines 56-64); and

- An important element of the invention is that it permits the customer to plan his or her shopping and shopping-related activities more efficiently ... To this end, the method also includes the step of communicating with the customer concerning the use of shopping aids other than incentives or coupons ... In one aspect of the invention, this communicating step includes transmitting a list of products available for purchase, receiving customer selections from the list of products, and then transmitting a shopping list to the customer (col. 2 lines 8-17).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the inventions of ZIP COUPONS and EXCITE to include displaying the list of the inventory of goods offered for sale by the selected retail outlet on the first computer such that the displayed inventory of goods are individually selectable by the consumer using the first computer so that the consumer may select one or more items of goods the consumer intends to purchase at the selected retail outlet, as disclosed by Scroggie et al., because this provides desirable and well known capabilities to the consumer/shopper and may influence the shopping habits of the consumer/shopper at the selected retail outlet or store.

Claim 2: ZIP COUPONS discloses means for acquiring identifying indicia for identifying the geographical location of a consumer unit connected thereto; selecting one or more participating retail outlets in the vicinity of the consumer unit; and downloading for display on the display monitor of the consumer unit the first file

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containing a list of the selected retail outlets (pg. 1 para. 2), e.g., *customers will select the US Postal zip code area where they want to shop and then select a coupon interest category for car wash, pizza,*

Claim 4: ZIP COUPONS discloses means for transmitting a file to the consumer unit containing a form requesting the consumer to identify the geographical location of the consumer unit (pg. 1 para. 2), *where customers select the U.S. Postal zip code area where they want to shop.*

Claim 5: ZIP COUPONS discloses a hardcopy apparatus for producing a hardcopy of electronic coupons transmitted to the consumer unit (pg. 1 para. 2), *as inferred by the capability where the customer can print out the desired coupons.*

Claim 6: ZIP COUPONS discloses a printer connected to a consumer unit (pg. 1 para. 2), *as inferred by the capability where the customer can print out the desired coupons.*

Claim 7: ZIP COUPONS and EXCITE do not explicitly disclose a point-of-sale unit located in a participating retail outlet, or a hardcopy apparatus. However, Official Notice is taken that it was old and well known at the time the invention was made that userstations or terminals for consumers' use were made available at participating retail outlets, e.g., in kiosks. Here, consumers may search for information on goods and products sold by the participating retail outlet and print coupons, as desired.

Additionally, Official Notice is taken that it was old and well known in the art at the time the invention was made that a computer typically is comprised of a display monitor, a

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memory for storing data to be displayed on the display monitor, a data processing unit; a hardcopy apparatus, a user input device, or any additional devices that are considered necessary for operation in a particular manner. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine ZIP COUPONS, EXCITE and old and well known art to disclose a point of sale unit comprising a hardcopy apparatus, a display monitor, a memory for storing data to be displayed on the display monitor, a data processing unit, a hardcopy apparatus, and a user input device, because this configuration provides functionality that is necessary for the invention to operate.

Claim 8: ZIP COUPONS discloses:

- the coupon server is located remotely from the point-of-sale unit (pg. 1 para. 2), and further comprises:
- means for transmitting to the point-of-sale unit a fourth file containing the identity of coupons for goods offered for sale by the retail outlet at which the point-of-sale unit is located (pg. 1 para. 2); which infers that goods for sale are identified by the list of coupons available.

ZIP COUPONS does not explicitly disclose the third means of the coupon server is responsive to the selection of one or more items of goods by the consumer to transmit the third file for display on the display monitor of the point-of-sale unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods. However, ZIP

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COUPONS does disclose the user selecting a postal ZIP code area where they want to shop (i.e., which can be remote from the coupon server), selecting coupons to be provided to the user from a displayed list of coupons for a coupon interest category selected by and displayed to the user, for goods that the user is interested in purchasing (pg. 1 para. 2). Further, EXCITE discloses *enables consumer access to valuable promotional offers matched to their shopping interests* (pg. 2 3rd para.), i.e., products that the consumer is interested in. Therefore it would have been obvious to one skilled in the art at the time the invention was made to use the methods of ZIP COUPONS in combination with EXCITE and Scroggie et al. to disclose the third means of the coupon server is responsive to the selection of one or more items of goods by the consumer to transmit the third file for display on the display monitor of the point-of-sale unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods, because this would provide the user with the coupons provided by selected merchants for the purchase of their products, thus encouraging shopping at their establishments.

Claim 12: ZIP COUPONS discloses one or more consumer units comprise client computers on a network (pg. 1 para. 2).

Claim 13: ZIP COUPONS discloses the coupon server comprises an Internet host computer (pg. 1 para. 2).

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(b) Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "ZIP COUPONS"), and further in view of "Excite Reports First Quarter 1999 Results," PR Newswire, 15 April 1999 (hereafter referred to as Excite), Scroggie et al. (U.S. Patent No. 6,014,634), and Katz et al. (U.S. Patent No. 6,055,513).

Claim 3: ZIP COUPONS discloses the communication medium comprises a public telephone network (col. 8 lines 2-7). ZIP COUPONS, Excite and Scroggie et al. do not disclose means for acquiring caller ID data to identify the geographical location of the consumer unit. However, Katz et al. disclose:

- the communication medium comprises a public telephone network (col. 15 lines 38-65), and
- means for acquiring caller ID data to identify the geographical location of the consumer unit (col. 16 lines 9-17).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine ZIP COUPONS, Excite, Scroggie et al., and Katz et al. to disclose the communication medium comprises a public telephone network and means for acquiring caller ID data to identify the geographical location of the consumer unit, because this capability provides obvious and useful enhancements to the invention for the expeditious identification of callers.

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(c) Claim 11, 29-30, and 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "ZIP COUPONS"), and further in view of "Excite Reports First Quarter 1999 Results," PR Newswire, 15 April 1999 (hereafter referred to as EXCITE), Scroggie et al. (U.S. Patent No. 6,014,634), and Burke (U.S. Patent No. 5,848,399).

Claim 11: ZIP COUPONS, Scroggie et al., and EXCITE do not disclose the second file contains graphical data for displaying a representation of the physical layout of the goods in the selected retail outlet. However, Burke discloses an output of the retail space management system 52 is a three-dimensional description 56 of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates. Typically, the description 56 includes a floor plan which indicates the location and sizes of each product category within the store. A file is also generated for each product category, indicating the product and shelf sizes and locations for the product category. This description 56 can be stored in a store database 61, accessible by an indication of the store 59 which it describes (col. 4 lines 58-67; col. 5 lines 1-25). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the invention of the combination of ZIP COUPONS, Scroggie et al., and EXCITE to disclose data representative of the physical layout of the participating retail outlets indicating the aisle location of the goods offered for sale, as disclosed by

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Burke, because this enhances the invention's desirability to consumers through the ease of locating desirable products in a store and may enhance customer attraction to the merchant.

Claim 29: Claim 29 is written as a system and contains essentially the same limitations as the combination of claims 1 and 11; therefore, the same rejection is applied.

Claim 30: Claim 30 is written as a system and contains essentially the same limitations as claim 2; therefore, the same rejection is applied.

Claim 32: Claim 32 is written as a system and contains essentially the same limitations as claim 4; therefore, the same rejection is applied.

Claim 33: Claim 33 is written as a system and contains essentially the same limitations as claim 5; therefore, the same rejection is applied.

Claim 34: Claim 34 is written as a system and contains essentially the same limitations as claim 6; therefore, the same rejection is applied.

Claim 35: Claim 35 is written as a system and contains essentially the same limitations as claim 7; therefore, the same rejection is applied.

Claim 36: Claim 36 is written as a system and contains essentially the same limitations as claim 8; therefore, the same rejection is applied.

Claim 37: Claim 37 is written as a system and contains essentially the same limitations as claim 11; therefore, the same rejection is applied.

Claim 38: Claim 38 is written as a system and contains essentially the same limitations as claim 13; therefore, the same rejection is applied.

Claim 39: Claim 39 is written as a system and contains essentially the same limitations as claim 13; therefore, the same rejection is applied.

Claim 40: Claim 40 is written as a system and contains essentially the same limitations as the combination of claims 1 and 11; therefore, the same rejection is applied.

(d) Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "ZIP COUPONS"), and further in view of "Excite Reports First Quarter 1999 Results," PR Newswire, 15 April 1999 (hereafter referred to as Excite), Scroggie et al. (U.S. Patent No. 6,014,634), Burke (U.S. Patent No. 5,848,399), and Katz et al. (U.S. Patent No. 6,055,513).

Claim 31: Claim 31 is written as a system and contains essentially the same limitations as claim 3; therefore, the same rejection is applied.

(e) Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "ZIP COUPONS"),

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and further in view of Scroggie et al (U.S. Patent No. 6,014,634) and Burke (U.S. Patent No. 5,848,399).

Claim 25: ZIP Coupons (see pg. 1 para. 2) discloses:

- using a first computer operated by a consumer to establish a connection with a second computer over a communication medium, *i.e., through their Internet connectivity*; and
- using a second computer to acquire identifying indicia for identifying the geographical location of the first computer; selecting from a list of participating retail outlets stored in the second computer one or more participating retail outlets in the geographical vicinity of the first computer; transmitting from the second computer to the first computer a first file containing the selected one or more participating retail outlets, each of which may be individually selected by the consumer using an input device; displaying on the first computer the list of the one or more selected participating retail outlets contained in the first file; transmitting from the second computer to the first computer a second file containing data corresponding to the selected retail outlet including a list of the inventory of goods offered for sale by the selected retail outlet; displaying the list of the inventory of goods offered for sale by the selected retail outlet on the first computer such that the displayed inventory of goods are individually selectable by the consumer using the first computer so that the consumer may select one or more items of goods the consumer intends to purchase at the selected retail outlet, as disclosed by Zip Coupons in:

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-- *by customers will go the planned Internet site ... via their computer or television, to obtain coupons for use in their local trading area ...*

-- *Customers will select the US Postal zip code area where they want to shop and then select a coupon interest category for car wash, pizza, dentist, pet care, health care, etc.*

-- *After viewing available coupons (which infers the customer viewing a list of products), the customer either can print out the desired coupons or use the on-line discount code number to participate in the merchant's special offer, which infers the customer choosing coupons which identify associated merchants (i.e., choosing desired merchants) from those presented for the geographical area (US Postal zipcode area) identified by customer (i.e., for trading in his local trading area of choice).*

Additionally, Scroggie discloses:

- using a first computer operated by a consumer to establish a connection with a second computer over a communication medium (col. 1 lines 47-64);
- using a second computer to acquire identifying indicia for identifying the geographical location of the first computer (col. 1 lines 52-61);
- selecting from a list of participating retail outlets stored in the second computer one or more participating retail outlets in the geographical vicinity of the first computer (col. 1 line 47 - col. 2 line 17);
- transmitting from the second computer to the first computer a first file containing the selected one or more participating retail outlets, each of which may be individually

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selected by the consumer using an input device (col. 1 lines 56-64), *disclosing the steps include logging in a remotely located customer using identity data and geographic region data transmitted by the customer over a communication network; transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region; and then receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised;*

- displaying on the first computer the list of the one or more selected participating retail outlets contained in the first file (col. 1 lines 56-64), *through the functionality of transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region;*

- transmitting from the second computer to the first computer a second file containing data corresponding to the selected retail outlet including a list of the inventory of goods offered for sale by the selected retail outlet (col. 1 lines 56-64), *through receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised; and*

- displaying the list of the inventory of goods offered for sale by the selected retail outlet on the first computer such that the displayed inventory of goods are individually selectable by the consumer using the first computer so that the consumer may select

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one or more items of goods the consumer intends to purchase at the selected retail outlet (col. 2 lines 8-17).

Neither Zip Coupons nor Scroggie et al. disclose transmitting from the second computer to the first computer a file containing data identifying the physical aisle location in the selected retail outlet of the goods selected by the consumer. However, Burke discloses an output of the retail space management system 52 is a three-dimensional description 56 of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates (col. 4 lines 58-67; col. 5 lines 1-25). Also, Official Notice is taken that it was old and well known in the art at the time the invention was made that the use of a database allows the cross-correlation of data relative to common features, characteristics or descriptors. Such cross-correlation of data allows the functionality of determining the physical location of specific products within a retail store and portraying the location information for specific products to the user, when the specific products are selected for purchase. This would require simple database search and display functions that are old and well known in the computer and database arts. Additionally, the functionality of the inventions of ZIP Coupons and Scroggie et al. discloses a database for data storage and retrieval. Also, Official Notice is taken that data that may be stored in a database may take any of many forms or formats, as may be required by the inventor for the desired functionality of the database, such as may be required to display a map, a table or a list. Therefore, it

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would have been obvious to one skilled in the art at the time the invention was made to modify the inventions of ZIP COUPONS and Scroggie et al. to disclose data representative of the physical layout of the participating retail outlets indicating the aisle location of the goods offered for sale, as disclosed by Burke, because this enhances the invention to consumers through the ease of generating a shopping list of desirable products from available products in a retail outlet and locating these desirable products in the retail outlet when shopping with the list.

Claim 26: ZIP COUPONS discloses (see pg. 1 para. 2) the communication medium comprises the Internet, the first computer comprises a client computer; and the second computer comprises an Internet host computer.

Claim 27: ZIP COUPONS and Scroggie et al. do not explicitly disclose the step of transmitting from the second computer to the first computer a second file further comprises the step of transmitting data representative of the physical layout of the selected retail outlet indicating the physical location of the goods offered for sale by the selected retail outlet. However, Burke discloses the step of transmitting from the second computer to the first computer a second file further comprises the step of transmitting data representative of the physical layout of the selected retail outlet indicating the physical location of the goods offered for sale by the selected retail outlet (col. 4 lines 58-67; col. 5 lines 1-25). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the inventions of ZIP

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COUPONS and Scroggie et al. to disclose the step of transmitting from the second computer to the first computer a second file further comprises the step of transmitting data representative of the physical layout of the selected retail outlet indicating the physical location of the goods offered for sale by the selected retail outlet, as disclosed by Burke, because this aids customers who generate shopping lists in finding the items they have selected to purchase in the retail outlet.

Claim 28: ZIP Coupons (see pg. 1 para. 2) discloses the step of transmitting from the second computer to the first computer a file containing electronic coupons corresponding to one or more of the selected goods in response to the selection of one or more items of goods by the consumer.

(11) Response to Argument

Appellants argue, at pg. 11, that, as further recited by independent claim 29, if coupons corresponding to the goods selected by the consumer are not available at the selected retail outlet, the inventive system transmits coupons for competitively-branded goods or for the selected goods at another retail outlet, in addition to transmitting a personalized shopping list. This subject matter of independent claim 29 is not disclosed or suggested by the prior art of record and was not addressed by the Examiner in the lengthy final rejection. Thus, claim 29 is believed to be patentable over the prior art. Moreover, this subject matter of claim 29 renders claim 29 separately patentable.

Examiner disagrees. Appellants presented this claim language in an "alternative" or "or" style. Examiner specifically rejected the other alternative. See sections (10) (a) & (10) (c) above.

Therefore, examiner maintains the rejection.

Appellants argue, on pg. 11-12 and , that claim 40 recites a system which has a server that contains data identifying an inventory of goods offered for sale and graphical data for displaying a representation of the retail outlets including a physical layout of the goods in the retail outlets. The server further contains means for transmitting to a consumer unit for display thereon a representation of a selected actual retail outlet including the physical layout of the goods in the selected retail outlet. This subject matter renders claim 40 separately patentable. The Examiner relied upon Burke as disclosing this claimed limitation, but failed to acknowledge the significant distinction between displaying a simulated retail outlet, as disclosed by Burke, and the representation of an actual retail outlet selected by the consumer from a virtually unlimited number of actual retail outlets, as required claim 40.

Examiner disagrees. Burke discloses that a retail space management system allows a retailer or other person to design a store layout, shelf by shelf. Information needed to use these programs can be created from scratch by auditing an actual store with a notebook computer and scanner wand (which captures UPC codes), or can be translated from the data files from any retail space management system currently used by the retailer by using InterSpace. An output of the retail space management system

52 is a three-dimensional description 56 of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates. Typically, the description 56 includes a floor plan which indicates the location and sizes of each product category within the store (col. 2 line 39 – col. 2 line 5). This disclosure encompasses Appellants' invention.

Therefore, examiner maintains the rejection.

Appellants argue, at pg. 12 and 20-21, that the prior art does not disclose or suggest the personalized shopping list containing goods selected by the consumer in a selected retail outlet along with the aisle locations of the selected goods in the selected retail outlet, as recited by each of independent claims 29 and 40. Although the Scroggie reference discloses a shopping list, the Scroggie shopping list merely provides the consumer with a list of food items needed to prepare a selected recipe along with available coupons. The personalized shopping list of the present invention contains aisle locations at any one of an unlimited number of retail outlets.

Examiner disagrees. Burke et al. discloses a shopping list in the context of the contents of the shopping cart of the Burke et al. invention. Included in the disclosure of Burke et al. is the disclosure: An indication of the purchased product, along with its original location on the shelf, is stored (col. 10 lines 6-8).

Therefore, Examiner maintains the rejection.

Appellants argue, at pg. 13, that, among the cited references to Zip Coupons, Excite, Scroggie and Katz, only Scroggie discloses a shopping list. However, the Scroggie shopping list differs from the claimed shopping list. None of the cited references disclose the personalized shopping list of the present invention which renders the present invention markedly distinct from the prior art.

Examiner disagrees. Scroggie et al. discloses, in one aspect of the invention, this communicating step includes transmitting a list of products available for purchase, receiving customer selections from the list of products, and then transmitting a shopping list to the customer (col. 2 lines 13-17). Scroggie et al. does not specifically disclose identifying the location of the product within a store on the shopping list. However, Burke et al. discloses the functionality of a shopping list through the use of a shopping cart which stores the selected products and their shelf locations (col. 9 line 63 – col. 10 line 18). Claims 29 and 40 stand rejected on the basis of Zip Coupons, Excite, Scroggie et al., Katz et al., and Burke, as the combination of cancelled claims 1 and 11 (see sections (10)(a) & (10)(c) above, and Final Action on pg. 15-16).

Therefore, Examiner maintains the rejection.

Appellants argue, on pg. 15-16, that Zip Coupons, either alone or in combination with one or more of Scroggie, Excite, and Katz, do not disclose or suggest a system for providing a shopping list identifying the physical location (aisle number) of the selected goods in the selected retail outlet, based on selections of goods by a consumer from a list of user-selectable goods available at a selected retail outlet.

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Examiner disagrees. Claims 29 and 40 were rejected in view of Zip Coupons, Excite, Scroggie et al. , and Burke et al. Scroggie et al. discloses In one aspect of the invention, this communicating step includes transmitting a list of products available for purchase, receiving customer selections from the list of products, and then transmitting a shopping list to the customer (col. 2 lines 13-17). Scroggie et al. does not specifically disclose identifying the location of the product within a store on the shopping list.

However, Burke et al. discloses:

- the functionality of a shopping list for display through the use of a shopping cart which stores the selected products and their shelf locations (col. 9 line 63 – col. 10 line 18); and
- a retail space management system allows a retailer or other person to design a store layout, shelf by shelf. Information needed to use these programs can be created from scratch by auditing an actual store with a notebook computer and scanner wand (which captures UPC codes), or can be translated from the data files from any retail space management system currently used by the retailer by using InterSpace. An output of the retail space management system 52 is a three-dimensional description 56 of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates. Typically, the description 56 includes a floor plan which indicates the location and sizes of each product category within the store (col. 2 line 39 – col. 2 line 5).

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Additionally, Claims 29 and 40 stand rejected on the basis of Zip Coupons, Excite, Scroggie et al., Katz et al., and Burke, as the combination of cancelled claims 1 and 11 (see sections (10)(a) & (10)(c) above, and Final Action on pg. 15-16). This disclosure encompasses Appellants' invention.

Therefore, examiner maintains the rejection.

Appellants argue, at pg. 17, that claims 29 and 40 recite a system and method in which a coupon server transmits and displays on a consumer unit a file containing a list of participating retail outlets for selection of a retail outlet by a consumer and another file containing the inventory of goods sold at the selected retail outlet (or a generic list of goods generally sold at a particular type of retail outlet). The server is responsive to consumer selections to distribute a list of selected goods identifying the aisle location of the selected goods in the selected retail outlet and optionally for distributing coupons based on the selected goods. Neither Zip Coupons, Scroggie or Excite disclose or suggest the claimed combination of structure or steps.

Examiner disagrees. The functionality of the coupon server is disclosed in the functionality of Zip Coupons, Scroggie or Excite, as presented in the rejection of claim 1 and 11 in section (10)(a) and (10)(c) above. Additionally, Scroggie et al. discloses In one aspect of the invention, this communicating step includes transmitting a list of products available for purchase, receiving customer selections from the list of products, and then transmitting a shopping list to the customer (col. 2 lines 13-17). Scroggie et al.

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does not specifically disclose identifying the location of the product within a store on the shopping list. However, Burke et al. discloses:

- the functionality of a shopping list for display through the use of a shopping cart which stores the selected products and their shelf locations (col. 9 line 63 – col. 10 line 18); and
- a retail space management system allows a retailer or other person to design a store layout, shelf by shelf. Information needed to use these programs can be created from scratch by auditing an actual store with a notebook computer and scanner wand (which captures UPC codes), or can be translated from the data files from any retail space management system currently used by the retailer by using InterSpace. An output of the retail space management system 52 is a three-dimensional description 56 of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates. Typically, the description 56 includes a floor plan which indicates the location and sizes of each product category within the store (col. 2 line 39 – col. 2 line 5).

Additionally, Claims 29 and 40 stand rejected on the basis of Zip Coupons, Excite, Scroggie et al., Katz et al., and Burke, as the combination of cancelled claims 1 and 11 (see sections (10)(a) & (10)(c) above, and Final Action on pg. 15-16). This disclosure encompasses Appellants' invention.

Therefore, examiner maintains the rejection.

Appellants argue, on pg. 17-18 and 20-21 that the claims do not recite a virtual on-line shopping system of the type disclosed by Burke, but recite the on-line generation of a customized shopping list for use at an actual retail outlet. Burke does not contemplate an actual retail outlet and discloses a hypothetical store having a hypothetical layout. The Burke "warehouse" does not exist in the physical world, so that no legitimate argument can be made that Burke somehow suggests the generation of a customized shopping list containing aisle numbers for use by a consumer while shopping at an actual store. Burke conveys a graphical representation of a non-existent store with shelves stocking as many as all of the 50,000 types of goods offered for sale throughout the entire country as maintained by national databases. The server of the Burke virtual store contains data identifying the virtual location of goods solely to graphically render the visual images of the hypothetical warehouse. However, the physical location data is not provided to the consumer in the form of an actual store layout and no shopping list of selected goods containing aisle numbers of the goods in the actual, selected retail outlet is provided by Burke as required by independent claims 29 and 40.

Examiner disagrees. Burke does disclose that a retail space management system allows a retailer or other person to design a store layout, shelf by shelf. Information needed to use these programs can be created from scratch by auditing an actual store with a notebook computer and scanner wand (which captures UPC codes), or can be translated from the data files from any retail space management system currently used by the retailer by using InterSpace. An output of the retail space

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management system 52 is a three-dimensional description 56 of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates. Typically, the description 56 includes a floor plan which indicates the location and sizes of each product category within the store (col. 2 line 39 – col. 2 line 5). This disclosure encompasses Appellants' invention.

Therefore, examiner maintains the rejection.

Appellants argue, at pg. 20, that claim 30 contains subject matter that is separately patentable. Claim 30 depends upon claim 29 and recites that the first means of the coupon server comprises means for acquiring identifying indicia for identifying the geographical location of a consumer unit connected thereto, selecting one or more participating retail outlets in the vicinity of the consumer unit, and downloading for display on the display monitor of the consumer unit the first file containing a list of the selected retail outlets. None of the cited references discloses the generation of a list of selected retail outlets as recited in claim 30.

Examiner disagrees. The references disclose the generation of a list of at least one selected retail outlet, which matches an alternative of the claim language, i.e., one or more, as presented in the rejection of claims 1, 11, 29, and 40 in section (10) above. Additionally, Scroggie et al. discloses In one aspect of the invention, this communicating step includes transmitting a list of products available for purchase, receiving customer selections from the list of products, and then transmitting a shopping list to the customer

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(col. 2 lines 13-17). Scroggie et al. does not specifically disclose identifying the location of the product within a store on the shopping list. However, Burke et al. discloses:

- the functionality of a shopping list for display through the use of a shopping cart which stores the selected products and their shelf locations (col. 9 line 63 – col. 10 line 18); and

- a retail space management system allows a retailer or other person to design a store layout, shelf by shelf. Information needed to use these programs can be created from scratch by auditing an actual store with a notebook computer and scanner wand (which captures UPC codes), or can be translated from the data files from any retail space management system currently used by the retailer by using InterSpace. An output of the retail space management system 52 is a three-dimensional description 56 of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates. Typically, the description 56 includes a floor plan which indicates the location and sizes of each product category within the store (col. 2 line 39 – col. 2 line 5).

Additionally, Claims 29 and 40 stand rejected on the basis of Zip Coupons, Excite, Scroggie et al., Katz et al., and Burke, as the combination of cancelled claims 1 and 11 (see sections (10)(a) & (10)(c) above, and Final Action on pg. 15-16). This disclosure encompasses Appellants' invention.

Therefore, examiner maintains the rejection.

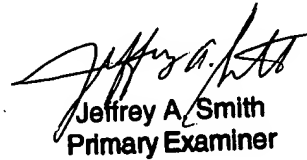
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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